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10/660,644	09/12/2003	Jurgen Prange	SRE-0005-US	7580

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PAUL, HASTINGS, JANOFSKY & WALKER LLP  
875 15th Street, NW  
Washington, DC 20005

EXAMINER
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SEREBOFF, NEAL

ART UNIT	PAPER NUMBER
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3626

MAIL DATE	DELIVERY MODE
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04/16/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/660,644	<b>Applicant(s)</b> PRANGE, JURGEN	
	<b>Examiner</b> NEAL R. SEREBOFF	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Notice to Applicant/ Response to Amendment***

1. In the Request for Continued Examination filed 2/11/2008, the following has occurred: Claims 1, 8 and 15 have been amended; Claims 23 – 27 have been added. Now, claims 1 – 27 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. As required by MPEP § 2181(I), claim 8 is being treated under 35 U.S.C. 112, 6<sup>th</sup> paragraph.
4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/11/2008 has been entered.
5. In the Office Action dated 7/31/2007, the Examiner made several Official Notice statements. The Applicant's reply, dated 2/11/2008, does not challenge the validity of those Official Notice statements. Therefore, these Official Notice statements become Applicant Admitted Prior Art (AAPA) and they are that:
  - The automated instructions are adapted to verify that the sum of all selected postings is in the business's favor.

Art Unit: 3626

- One of ordinary skill in the art would have added this feature with the motivation to clearly see all the positions of a business or a customer online to make determining profits easier.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1 – 14 and 21 – 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claims 1 and 8 include the limitation “automated instructions that, when executed by the server, configure the server to:.” There is no mention within the detailed description regarding automated instructions and server configuration. Claims 2 – 7, 9 – 14 and 21 – 23 are rejected for the same reasons as they are dependent upon claims 1 and 8 respectively. The Examiner understands these instructions to be parameters or options.

8. Claims 24 – 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 24 includes:

Art Unit: 3626

- “Remotely accessing a insurer account by an insurer, including internal records of a reinsurer providing coverage to the insurer for clients of the insurer, the account being maintained by the reinsurer” The Examiner cannot find support for the account being maintained by the reinsurer. The Examiner understands that the server is maintained by the reinsurer.
- “Accessing a computer graphical user interface that displays a list of open current account bookings for the clients of the insurer, wherein the open current account bookings are associated with more than one insurance policy in which the reinsurer is obligated to provide reinsurance coverage to the insurer” The Examiner finds no support for the account listing claimed. Further the Examiner finds no support for how the current account bookings are associated with more than one insurance policy. The Examiner understands this to be a listing on a computer display.
- “Instructing the reinsurer to make an upcoming payment for an upcoming event, to request a payment from the reinsurer from a previous event, or to pair a payment with one or more upcoming events” The Examiner notes that the customer making payments as described within the Detailed Description is the Insurance Company and not the Reinsurance Company. Therefore, the Examiner finds no support for this limitation. The Examiner understands this to be that the Reinsurance Company will pay claims.
- Claims 25 – 27 are rejected for the same reasons as being dependent upon claim 24.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 8 – 14 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8 includes a “means for configuring” without corresponding structure within the detailed description. Claims 9 – 14 and 23 are rejected for the same reason as they are dependent upon claim 8.

11. Claim 24 – 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 24 includes “wherein instructing the reinsurer to pair a payment with one or more upcoming events comprises using the list to pair a payment associated with a certain insurance policy of the insurer with an upcoming event associated with an existing reinsurance policy between the insurer and reinsurer.” The Examiner notes that this limitation will only occur if the “instructing the reinsurer” option is chosen and therefore the limitation is not clear. Claim 26 includes the same language as claim 24 and therefore refers to optional limitations that are not chosen. Claims 25 and 27 are rejected for the same reasons as they depend upon claim 24.

***Claim Rejections - 35 USC § 102***

12. ***Claims 1 – 20 and 23 – 27*** are rejected under 35 U.S.C. 102(e) as being anticipated by Lundegren, U.S. Pre-Grant Publication Number 2002/ 0143584.

13. As per claim 1, Lundegren teaches a system for transacting business between a customer and a business, the system comprising:

- A server used by the business and being accessible by the customer, wherein the business is a reinsurer and the customer is an insurer (see figure 1); and

Art Unit: 3626

- A customer account housed on the server (see paragraphs 27, 36 and 37), the customer account having access to internal records associated with the customer account on the server (paragraph 37 where the client is allowed selected information),
  - Wherein the customer account includes automated instructions that, when executed by the server, configure the server (paragraph 42, where the parameters are set): that allow the customer
    - To advise the business of an upcoming payment for an upcoming event (see figure 6 where upcoming is a future time),
    - To request a payment from the business from a previous event, or
    - To pair a payment with one or more previous events,
  - Wherein the automated instructions are adapted to present on a computer graphical user interface a list of open current account bookings of the customer (see figure 3 where the customer could have more than one position open),
  - Wherein the open current account bookings are associated with more than one insurance policy (see figure 3 where an unlimited number of positions are possible), and
  - Wherein, using the list, the customer is able to pair a payment associated with a certain insurance policy with a previous event associated with the certain insurance policy (see figure 2 where terms are specified).

Art Unit: 3626

14. As per claim 2, Lundegren teaches the system of claim 1 as described. Lundegren further teaches the system wherein the previous event is a claim submitted by the customer to the business, and wherein payment is owed to the customer for the claim (see paragraph 46).

15. As per claim 3, Lundegren teaches the system of claim 2 as described. Lundegren further teaches the system wherein the claim relates to an insurance claim (see paragraph 46).

16. As per claim 4, Lundegren teaches the system of claim 1 as described. Lundegren further teaches the system wherein the upcoming event is a premium payment for an insurance policy (see paragraph 45 and 81 where the premium is collected at some future time).

17. As per claim 5, Lundegren teaches the system of claim 1 as described. Lundegren further teaches the system comprising a computer in communication with the server (see figure 1), wherein the customer accesses the server through the computer (see figure 1).

18. As per claim 6, Lundegren teaches the system of claim 5 as described. Lundegren further teaches the system wherein the access to the server from the computer includes use of the Internet (see figure 1).

19. As per claim 7, Lundegren teaches the system of claim 5 as described. Lundegren further teaches the system wherein the access to the server from the computer is remote (see figure 1).

20. As per claim 8, Lundegren teaches a system for transacting business between a customer and a business, the system comprising:

- A server used by the business and being accessible by the customer, wherein the business is a reinsurer and the customer is an insurer (see figure 1); and
- A customer account housed on the server (see paragraphs 27, 36 and 37),



Art Unit: 3626

- A customer account housed on the server (see paragraphs 27, 36 and 37), the customer account being configured to permit access to individual records associated with the customer account the customer account including means for configuring the server to perform a process associated with the customer account,
  - The customer account includes means for
    - Advising the business of an upcoming payment for an upcoming event (see figure 6 where upcoming is a future time and the means is a computer web page),
    - To request a payment from the business from a previous event, or
    - To pair a payment with one or more previous events,
- Wherein the automated instructions are adapted to present on a computer graphical user interface a list of open current account bookings of the customer (see figure 3 where the customer could have more than one position open),
- Wherein the open current account bookings are associated with more than one insurance policy (see figure 3 where an unlimited number of positions are possible), and
- Wherein, using the list, the customer is able to pair a payment associated with a certain insurance policy with a previous event associated with the certain insurance policy (see figure 2 where terms are specified).

21. As per claim 9, Lundegren teaches the system of claim 8 as described above. Lundegren further teaches the system wherein the previous event is a claim submitted by the customer to the business, and wherein payment is owed to the customer for the claim (see paragraph 46).

Art Unit: 3626

22. As per claim 10, Lundegren teaches the system of claim 9 as described above.

Lundegren further teaches the system wherein the claim relates to an insurance claim (see paragraph 46).

23. As per claim 10, Lundegren teaches the system of claim 8 as described above.

Lundegren further teaches the system wherein the upcoming event is a premium payment for an insurance policy (see paragraphs 45 and 81 where the premium is collected at some future time).

24. As per claim 12, Lundegren teaches the system of claim 8 as described above.

Lundegren further teaches the system comprising a computer in communication with the server (see figure 1), wherein the customer accesses the server through the computer (see figure 1).

25. As per claim 13, Lundegren teaches the system of claim 12 as described above.

Lundegren further teaches the system wherein the access to the server from the computer includes use of the Internet (see figure 1).

26. As per claim 14, Lundegren teaches the system of claim 12 as described above.

Lundegren further teaches the system wherein the access to the server from the computer is remote (see figure 1).

27. As per claim 15, Lundegren teaches a method of transacting business between a customer and a business, the method comprising:

- Accessing an existing customer account (paragraph 37, where the customer account exists and the customer has secure access), including internal records of the business (paragraph 37 where the client is allowed selected information), on a server used by the business, wherein the business is a reinsurer and the customer is an insurer (see figure 1); and

- Accessing a computer graphical user interface that displays a list of open current account bookings of the customer, wherein the open current account bookings are associated with more than one insurance policy (see figure 6), and
- Instructing the business
  - To make an upcoming payment for an upcoming event (see figure 6 where upcoming is a future time),
  - To request a payment from the business from a previous event, or
  - To pair a payment with one or more upcoming events ,
- Wherein instructing the business to pair a payment with one or more upcoming events comprises using the list to pair a payment associated with a certain insurance policy with an upcoming event associated with the certain insurance policy (see figure 2 where terms are specified).

28. As per claim 16, Lundegren teaches the method of claim 15 as described above.

Lundegren further teaches the method wherein the previous event is a claim submitted by the customer to the business, and wherein payment is owed to the customer for the claim (see paragraph 46).

29. As per claim 17, Lundegren teaches the method of claim 16 as described above.

Lundegren further teaches the method wherein the claim relates to an insurance claim (see paragraph 46).

30. As per claim 18, Lundegren teaches the method of claim 15 as described above.

Lundegren further teaches the method wherein the upcoming event is a premium for an insurance policy (see paragraph 45 and 81 where the premium is collected at some future time).

31. As per claim 19, Lundegren teaches the method of claim 15 as described above.

Lundegren further teaches the method wherein accessing the customer account involves use of the Internet (see figure 1).

32. As per claim 20, Lundegren teaches the method of claim 15 as described above.

Lundegren further teaches the method wherein the customer account is accessed remotely (see figure 1).

33. As per claim 23, Lundegren teaches the system of claim 8 as described above.

Lundegren further teaches the system wherein the process is at least one of advising the business of an upcoming payment for an upcoming event, request a payment from the business from a previous event or to pair a payment with one or more previous events (paragraph 45, where the payment terms are specified and therefore indicate an upcoming payment).

34. As per claim 24, Lundegren, as understood, teaches a method comprising:

- Remotely accessing a insurer account by an insurer, including internal records of a reinsurer providing coverage to the insurer for clients of the insurer (paragraph 27 for a web page and paragraph 37 where the client is allowed selected information), the account being maintained by the reinsurer (paragraph 27);
- Accessing a computer graphical user interface that displays a list of open current account bookings for clients of the insurer, wherein the open current account bookings are associated with more than one insurance policy in which the reinsurer is obligated to provide reinsurance coverage to the insurer (figure 6), and
- Instructing the reinsurer
  - To make an upcoming payment for an upcoming event,

- To request a payment from the reinsurer from a previous event, or
- To pair a payment with one or more upcoming events (paragraph 81 where the event is a claim),
- Wherein instructing the reinsurer to pair a payment with one or more upcoming events comprises using the list to pair a payment associated with a certain insurance policy of the insurer with an upcoming event associated with the certain insurance policy in accordance with an existing reinsurance policy between the insurer and the reinsurer (Optional Language, Not Chosen).

35. As per claim 25, Lundegren teaches the method of claim 24, as understood, as described above. Lundegren further teaches the method wherein the insurer account includes a bordereaux (The Examiner notes that the 'bordereaux' is considered nonfunctional descriptive information and therefore has no patentable weight. Any insurance company information, such as company name on figure 5, equally anticipates this limitation).

36. As per claim 26, Lundegren teaches the method of claim 24, as understood, as described above. Lundegren further teaches the method wherein instructing the reinsurer to make an upcoming payment includes off-setting debit and credit items for the insurer (Optional Language, Not Performed).

37. As per claim 27, Lundegren teaches the method of claim 24, as understood, as described above. Lundegren further teaches the method further comprising generating a record of the payment made with the certain insurance policy (The Examiner notes the positive step of generating a record includes the non-functional descriptive information of the information within

that record. Therefore, a creation of a record as described in paragraph 55 where the storing of information, a recording, anticipates this claim).

***Claim Rejections - 35 USC § 103***

38. **Claim 21** is rejected under 35 U.S.C. 103(a) as being unpatentable over Lundegren, U.S. Pre-Grant Publication Number 2002/ 0143584 in view of AAPA.

39. As per claim 21, Lundegren teaches the system of claim 1 as described.

Lundegren further teaches the system wherein the customer advises of an upcoming payment by selecting postings on the list (see figure 2 where payment terms are described).

Lundegren does not explicitly teach the system wherein the automated instructions are adapted to verify that the sum of all selected postings is in the business's favor.

It is AAPA that the automated instructions are adapted to verify that the sum of all selected postings is in the business's favor.

One of ordinary skill in the art at the time of the invention would have added the Official Notice feature to Lundegren. One of ordinary skill in the art would have added this feature with the motivation to clearly see all the positions of a business or a customer online to make determining profits easier (AAPA).

40. **Claim 22** is rejected under 35 U.S.C. 103(a) as being unpatentable over Lundegren, U.S. Pre-Grant Publication Number 2002/ 0143584 in view of Goino, U.S. Pre-Grant Publication Number 2001/ 0056396.

41. As per claim 22, Lundegren teaches the system of claim 1 as described.

Lundegren does not explicitly teach the system wherein the customer requests a payment by selecting postings on the list, and wherein the automated instructions are adapted to verify that the sum of all selected postings is in the customer's favor.

However, Goino teaches the system wherein the customer requests a payment by selecting postings on the list (see paragraph 371 where a bidders list is shown), and wherein the automated instructions are adapted to verify that the sum of all selected postings is in the customer's favor (see paragraph 372).

One of ordinary skill in the art at the time of the invention would have added these features to Lundegren. One of ordinary skill in the art would have added these features with the motivation to satisfy that requirements other than the price for a client are provided (see Goino abstract).

#### ***Response to Arguments***

42. Applicant's arguments regarding the finality of the last rejection are not persuasive. The Applicant states that the "previous amendment did not necessitate the implication of new art." In proof, the Applicant states that the "amended material would have been within the scope of the original search in the as filed claims." The reason that the amended information would have been included within the original search was that the original search was broad and therefore covered more material. Therefore, a narrowing of the claims required a new search to focus upon the amended invention. The amended claims were narrow enough that the original art was no longer adequate and therefore necessitated new art.

43. The Applicant's statement that "if the finality of the pending Action were to be maintained, this would place an undue burden on Applicant." The Examiner notes that no proof

was provided with the Applicant's opinion regarding the burden of the Assignee, Swiss Reinsurance Corporation.

44. Applicant's arguments filed 2/11/2008 have been fully considered but they are not persuasive.

- The Applicant amended independent claims 1, 8 and 15 with the expectation that the claims would no longer be anticipated by Lundegren. However, the Examiner has updated the Lundegren rejections as detailed above.
- The Examiner notes that claim 15 introduces the new limitation of an “existing customer.” The Examiner interprets the existing time period to be a current customer. Although not claimed, the Applicant could have made the differentiation of New Customers and Returning Customers. The Examiner notes that the creation of accounts and the storing of accounts for later access have preceded the Applicant’s priority date by many years in companies such as Ebay, Amazon.com, and uBid.com.
- The Applicant argues that “the Office's position fails to provide an explanation as how one of skill in the art, at the relevant time, would have known of the contended teaching within the knowledge of one of ordinary skill in the art.” The Examiner notes that the rebuttal to an Official Notice statement must include proof that the Official Notice was taken in error. As only an unsubstantiated argument was provided, the Examiner understands these Official Notice statements to be Applicant Admitted Prior Art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEAL R. SEREBOFF whose telephone number is (571)270-



1373. The examiner can normally be reached on Mon thru Thur from 7:30am to 5pm, with 1st Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. R. S./  
Examiner, Art Unit 3626  
3/25/2008

/Robert Morgan/  
Primary Examiner, Art Unit 3626